

Application Serial No.: 09/825,210  
Filing Date: April 2, 2001

Reply to Office action of: 07/02/2004  
Attorney Docket No.: ARC920010034US1

### REMARKS

Applicant respectfully submits that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

### THE CLAIMS

Claims 1 - 3, 5 - 7, 10 - 13, 15 - 17, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Farber et al. (US 6,654,807 B2), hereinafter referred to as "Farber". Applicant respectfully submits that Farber does not disclose all the elements and limitations of the rejected claims. Consequently, the claims presently on file are not obvious in view of Farber, and the allowance of these claims is earnestly solicited. In support of this position, Applicant submits the following arguments:

#### A. Legal Standard of Obviousness

The following legal authorities set the general legal standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

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must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

- In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).
- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

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- "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1363, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references,

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standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." See *In re Rouffet*, 149, F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).
- If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

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### **B. Brief Summary of the Present Invention**

#### **B.1. Problems addressed by present invention**

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention in view of the problem it addresses. Once a web document is saved, the Internet (or hyperlink) context from a source document to a destination document, passing by one or more intervening target documents, is lost. Consequently, the user will not be able to return from the destination document to the source document, nor would it be possible for the user to return to the download location of the document, since this information is also lost during the save process. Current technology does not recognize the need for such a save process, let alone provide a solution thereto.

#### **B.2. Summary of the present invention**

The document association system and method of the present invention satisfy this need by bundling (or associating) and synchronizing a target document (i.e., a web page) and the context of a source document as metadata to intervening target documents during a save process. Accordingly, users will be able to return to the source document, and optionally to use applications for automatically synchronizing a destination document to the target document.

The context of the source document may include, for example, one or more of the following parameters:

- The location or address, such as the URL, of the source document;
- the path, such as pages examined to navigate from the source document to the target document; and
- the input parameters required to generate the target document, such as

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the search query inputted by the user.

When a user wishes to access the source document, the system uses the saved context metadata to link the user to the source document. The system is also capable of synchronizing the target document(s) to the destination document. When coupled with a synchronization application, the system allows the user to update the destination document to reflect changes in the target document(s), allowing a convenient mechanism for updating saved documents. The synchronization application performs a comparison of the destination document with the target document to detect changes and to automatically update the destination document. If the target document were deleted from its original location or relocated, the destination document is marked as orphaned.

### C. Application of the Obviousness Standard to the Present Invention

Claim 1 as currently amended, includes the limitations of prior claims 2 - 4, and thus, Applicant will present arguments in response to the rejected claims 1 - 4, as part of the arguments in support of the allowance of claim 1 on file.

Regarding claim 1, the Examiner states that: "Farber et al. teach that ... when the client requests other resources based on identifiers in the particular requested resource, the client will make those requests directly to the selected repeater, bypassing the reflector and origin server entirely (Column 3, lines 39 — 49) ... Farber et al. do not explicitly teach bundling ... as attributes of the target document. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to do so using the invention of Farber et al. because the skilled artisan would want to ensure that the resource and

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the modified resource identifier are appropriately matched so as to provide a better way of processing resource requests in a computer network (Column 3, lines 1 and 2).

Regarding dependent claims 2 and 3, Farber et al. teach that if the repeater has a local copy of the resource then it returns that copy, otherwise it forwards the request to the origin server to get the resource, and saves a local copy of the resource in order to serve subsequent requests (Column 3, lines 23 - 27) ... (Column 3, lines 39 - 44) ... Farber et al. do not explicitly teach merging ... as integral attributes of the target document ... (Column 3, lines 1 and 2).

Regarding dependent claim 4, Farber et al. do not explicitly teach synchronizing. However, Heninger et al. do teach that in the case of caches, it is also useful to generate a source command to be placed in your target script referring back to the source script. This ensures that the target stays synchronized with the source (Column 16, lines 16 — 20) ... (Column 2, lines 49 — 52)." Emphasis added.

Applicant agrees with the Examiner that Farber does not explicitly teach the following features that are recited in claim 1:

1. bundling ... as attributes of the target document;
2. merging ... as integral attributes of the target document; and
3. teach synchronizing.

Based on the legal authorities above, neither Farber, Heninger et al., nor the combination thereof, describes essential elements of the present invention, and consequently, claim 1, as amended is not obvious in view of these references. In support of this position, Applicant respectfully submits the following definitions that are contained in the instant application, in order to help in the understanding of certain terms in claim 1:

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Destination document: A final document or web page which is comprised of a target document that is bundled with contextual data about the source document.

Contextual data include, for example, the input parameters 172, the destination URL 176, and the URL 174 of the source document 50.

Source document: An initial document or web page that points, whether directly or indirectly, to a target document and/or to a destination document.

Target document: A special intermediate document or web page that points directly to a destination document.

Farber expressly states that: "If the particular requested resource itself can contain identifiers of other resources, then the resource may be rewritten (before being provided to the client). In particular, the resource is rewritten to replace at least some of the resource identifiers contained therein with modified resource identifiers designating a repeater instead of the origin server. As a consequence of this rewriting process, when the client requests other resources based on identifiers in the particular requested resource, the client will make those requests directly to the selected repeater, bypassing the reflector and origin server entirely." (Column 3, lines 39 - 49).

In other terms, the modified resource identifier in Farber no longer contains the original resource, which defeats the purpose of the present invention that specifically contains contextual data about the source document. In this respect, Farber seems to teach away from the present invention.

The Examiner argues that "it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to do so using the invention of Farber et al. because the skilled artisan would want to ensure that

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the resource and the modified resource identifier are appropriately matched so as to provide a better way of processing resource requests in a computer network (Column 3, lines 1 and 2)." Emphasis added.

In response, Applicant respectfully submits that the general reason relied upon by the Examiner, namely "to provide a better way of processing resource requests in a computer network," does not provide a sufficiently specific technical ground for rejecting claim 1. In fact, improving computer processing resource requests is a very generic objective that is applicable to a vast majority of computer related designs.

Farber does not teach saving a web page along with specific attributes of the source document and the intervening target documents. In addition, since Farber deflects the quest to alternative sources, i.e., other than the original source document, indicates that Farber does not, in certain circumstances allow access to the source document.

The Examiner states that: "Farber et al. do not explicitly teach merging ... as integral attributes of the target document. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to do so using the invention of Farber et al. because the skilled artisan would want to ensure that the resource and the modified resource identifier are appropriately matched so as to provide a better way of processing resource requests in a computer network (Column 3, lines 1 and 2)." Emphasis added.

In essence, the Examiner bases the rejection ground on the same generic argument, namely "to provide a better way of processing resource requests in a computer network". Applicant therefore incorporate by reference the

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arguments made earlier in overcoming this rejection ground, without having to repeat the same arguments.

The Examiner further states that: "Farber et al. do not explicitly teach synchronizing. However, Heninger et al. do teach ... automatically synchronizing the destination document to the target document. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Farber et al. with that of Heninger et al. because such a combination would provide the users of Farber et al. with a server side scripting language and programming tool designed to simplify programming for web pages using databases or other dynamic information (Column 2, lines 49 - 52)." Emphasis added.

Applicant respectfully submits that the invention is not limiting to the step of synchronizing in an abstractual way, but rather in combination with the remaining elements and features of claim 1. More specifically, the present invention recites automatically synchronizing the destination document to the target document, to reflect changes in the target document. The synchronization step, in conjunction with the bundling step, enables the present invention to track down the source document even if the target documents change. This feature is not taught in the cited references, whether considered individually or in combination with each other, and none of the references suggests such combination. As a result, the two cited references cannot be properly combined.

Therefore, claim 1 and the claims dependent thereon are allowable, and such allowance is respectfully requested. In addition, with respect to the dependent claims, Applicant does not assert each individual feature

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independently in an abstractual way, but rather in combination with the elements and features of claim 1.

Independent claims 11 and 20 are also allowable for reciting generally similar elements and limitations to those of claim 1. As a result, claims 11 and 20 and the claims dependent thereon are allowable and such allowance is respectfully requested.

**D. New Claims**

Applicant submits that the new claims 21 through 26 as they contain elements that are generally similar to those of claims 5 - 10.

**CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted.

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